REMARKS

The Examiner rejected Claims 19-28 under 35 U.S.C.112, second paragraph, because of the use of the term "composition". The above amendments remove the term in question.

The Examiner advised that should Claims 1 and 19 be allowable, Claims 1 and 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Applicant respectfully disagrees with the Examiner's reading of the claims. Claim 1 includes the limitation "said absorbent layer being divided into a plurality of cells for containing liquid", which is absent from Claim 19. Hence, the claims are no more duplicative of one another than a dependent claims is duplicative of the claim from which it depends.

The Examiner rejected Claim 7 under 35 U.S.C. 112, first paragraph, because the claim contains the phrase "an appropriate pattern". Applicant can find no such limitation in Claim 7. If the Examiner can clarify this rejection, Applicant will address it.

The Examiner rejected Claims 1-2, 19-20, and 27-28 under 35 U.S.C. 102(b) as being anticipated by USPN 4,312,907 to Hiraoka, *et al* (hereafter "Hiraoka"). Applicant traverses this rejection.

The Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. In re King, 231 USPQ 136, 138 (Fed. Cir. 1986); Kalman v. Kimberly-Clark Corp., 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264,

1268, 20 USPQ2d 1746, 1749(Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re* Rijckaert, 28 USPQ2d, 1955, 1957).

In making this rejection, the Examiner stated that Hiraoka teaches a water-impermeable sheet material comprised of a fiber sheet substrate having a water impermeable layer attached thereto. According to the Examiner, Hiraoka teaches that the water impermeable layer has pores that can be formed by electrical discharge, and hence, the layer is electrostatically charged.

Since Hiraoka does not teach that the layer in question is electrostatically charged, the Examiner must be arguing that it is inherent that a sheet through which a spark passes becomes electrostatically charged. The Examiner's argument rests on the assumption that any time a material is subjected to an electrical discharge the material becomes electrostatically charged. Applicant respectfully disagrees. The mere fact that a spark passes through a sheet of material does not necessarily imply that a net charge is left on the sheet of material. Accordingly, Applicant submits that the Examiner has not made a *prima facia* case for anticipation with reference to Claims 1 and 19 and the claims dependent therefrom.

The Examiner rejected Claims 1, 2, 5, 19, 27, 28, 20 and 23 under 35 U.S.C. 102(b) as being anticipated by Babb, *et al* (hereafter "Babb"). Applicant traverses this rejection.

In making this rejection, the Examiner looks to a teaching that the adhesion characteristics of the substrate for polymer deposition thereon may be enhanced by surface treatment such as corona discharge methods. Once again, the Examiner has not pointed to any explicit teaching that one of the surfaces of this material is electrostatically charged when the material is completed. Accordingly, Applicant must assume that the Examiner is arguing that this is an inherent characteristic of corona discharge treatment. Applicant must disagree.

Corona discharge treatment chemically alters the surface chemistry by exposing the surface to reactive ions. In some cases, this can lead to an electrostatic charge being placed on the surface, in others it does not. Furthermore, even if the treatment led to an electrostatic charge being deposited on the substrate, that charge would have to survive the subsequent polymer deposition steps in the method taught by Babb. As is well known in the electret arts, surface charges provided by corona treatment are easily removed by exposure contact with other materials, moisture, or exposure to air for extended periods of time. Hence, the Examiner has not shown that the treatment in question was one that necessarily leads to an electrostatically charged surface. Accordingly, Applicant submits that the Examiner has not made a *prima facia* case for anticipation with reference to Claims 1 and 19 and the claims dependent therefrom.

In addition, with reference to Claim 1, while the phrase "spilled on" may refer to an intended use and hence be ignored, the remainder of the phrase, i.e., "plurality of cells for containing liquid" is a patentable limitation. The Examiner has not pointed to any teaching in Babb that any of the porous layers taught therein serve this function. The fact that the cell structures are porous shows that the cells do not contain liquid. Accordingly, there are additional grounds for allowing Claim 1.

The Examiner rejected 1-8 and 19-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 4,797,310 to Barby, *et al* (hereafter "Barby") in view of USPN 4,312,907 to Hiraoka, *et al*, and USPN 3,709,221 to Riely. Applicant traverses this rejection.

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the

combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success... Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

In making this rejection, the Examiner stated that Barby teaches an article for absorbing liquid or delivering liquid. The Examiner admits that Barby does not teach an electrostatically charged sheet or the electrostatically charging of a foam or fibrous mat. The Examiner looks to Hiraoka for the teaching of an electrostatically charged sheet.

As pointed out above, Hiraoka does not teach an electrostatically charged sheet. Hiraoka teaches producing pores by passing a spark through a substrate to create a hole through the substrate. There is no mention of an electrostatically charged sheet in any of the references. As noted above, the Examiner has not provided any evidence that passing a spark through a substrate always leads to the substrate being electrostatically charged. In addition, even if such an operation left a charge on the substrate, the charge would have to survive the subsequent bonding and other processing operations to lead to an article satisfying the claims in question. Once again, the Examiner has not pointed to any teaching to that effect.

The Examiner also states that both Hiraoka and the present invention use the "electrostatic sheet" for the same purpose, namely, preventing the condensation of moisture, and hence, there is a motivation for combining the teachings. Applicant must disagree. First, the present invention is used for protecting a surface from liquid spills, not from moisture condensing on the surface.

Second, the issue is whether or not one would be led to combine the teachings of Barby and Hiraoka. If anything, the inventions of Barby and Hiraoka are directed to unrelated problems. Barby is concerned with a liquid permeable article for holding a liquid in a form that can be released by pressure. Hiraoka is directed to an article that is water-impermeable and that prevents the condensation of water on a surface. Accordingly, Applicant submits that the Examiner has not made a *prima facia* case for obviousness under 35 U.S.C. 103 for Claims 1 and 19 or the claims dependent therefrom.

With reference to Claims 3 and 21, the Examiner admits that Barby does not teach an open cell foam sheet. The Examiner looks to Hermann as teaching open-cell foam. The Examiner maintains that using open-cell foam would provide extra strength to the material, and hence, there is a rationale for combining the teachings of the reference. Applicant must disagree.

First, Barby is directed to a specific class of moisture permeable substrates that hold very large amounts of liquid compared to their weight. It is these unique substrates that provide the advantages claimed in Barby. The Examiner has not pointed to any teaching in Hermann of open-cell foam that provides these advantages. Hence, there is no teaching of a material that would satisfy the limitations of the absorbent material in Barby.

Second, the Examiner has not pointed to any suggestion that increasing the strength of the material taught in Barby is of any use, or that an open cell foam would be stronger than the materials already taught in Barby. Accordingly, there are additional grounds for allowing Claims 3 and 21.

With reference to Claims 6 and 24, the Examiner admits that Barby does not teach using a fibrous mat as the absorptive layer. The Examiner looks to Riely for the teaching of a porous mat in a surgical dressing. According to the Examiner it would have been obvious to one of ordinary skill in the art to modify the article of Barby to include a fibrous mat since Riely teaches forming a fibrous mat results in a greater absorptivity per volume of absorbent material. The Examiner cites col. 5, line 30 of Riely for this proposition.

First, the issue is whether the fibrous mat would provide a greater absorptivity than the material taught in Barby. The Examiner has not pointed to any such teaching in the art or the reference. Absent such greater absorptivity, no none would replace the material taught in Barby with that taught in Riely, as the purpose of the Barby reference is to provide high absorptivity.

Second, the passage cited by the Examiner refers to a specific mat taught in Riely, which provides more absorptivity than other mats when the mat is to be compressed. Since the Examiner has not shown that this specific mat would be more useful than the absorptive material taught in Barby, the Examiner has failed to show a motivation for making the replacement postulated by the Examiner. Accordingly, there are additional grounds for allowing Claims 6 and 24.

The above amendments to Claims 1, 25, and 28 remove the "spilled" limitation that the Examiner maintains has no patentable weight.

I hereby certify that this paper is being sent by FAX to 703-872-9310.

Respectfully Submitted,

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